

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>EGT-005-1C</b>					
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number <b>10/761,864</b>	Filed <b>01/20/2004</b>					
	First Named Inventor <b>Richard Paul White</b>						
	Art Unit <b>2444</b>	Examiner <b>Paul H Kang</b>					
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding-bottom: 10px;"><input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)  <input checked="" type="checkbox"/> attorney or agent of record. Registration number <b>46,633</b></td><td style="width: 50%; vertical-align: top; padding-bottom: 10px; text-align: right;">/Trevor Coddington/ _____ Signature <b>Trevor Coddington</b> _____ Typed or printed name  <b>760-809-4275</b> _____ Telephone number  <b>5/6/09</b> _____ Date</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td></td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)  <input checked="" type="checkbox"/> attorney or agent of record. Registration number <b>46,633</b>	/Trevor Coddington/ _____ Signature <b>Trevor Coddington</b> _____ Typed or printed name  <b>760-809-4275</b> _____ Telephone number  <b>5/6/09</b> _____ Date	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	
<input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)  <input checked="" type="checkbox"/> attorney or agent of record. Registration number <b>46,633</b>	/Trevor Coddington/ _____ Signature <b>Trevor Coddington</b> _____ Typed or printed name  <b>760-809-4275</b> _____ Telephone number  <b>5/6/09</b> _____ Date						
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____							
<input type="checkbox"/> *Total of _____ forms are submitted.							

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 10/761,864 Confirmation No.: 3151  
Applicant : Richard P. WHITE, *et al.*  
Filed : January 20, 2004  
Title : AN UNSOLICITED MESSAGE DIVERTING COMMUNICATIONS  
: PROCESSOR  
Art Unit : 2444  
Examiner : Paul H. KANG  
Docket No. : EGT-005-1C

**Mail Stop AF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF**

Dear Sir:

In response to the final Office Action mailed on January 7, 2009, Applicant respectfully requests pre-appeal reconsideration of the final rejections of record in view of the following remarks. No amendments are being filed with this request. Claims 1-17 are currently pending.

**I. The Provisional Double Patenting Rejection of Claims 1-17**

Claims 1-17 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending U.S. Patent Application No. 10/761,883, claims 1-15 of copending U.S. Patent Application No. 10/761,894, and claims 1-24 of copending U.S. Patent Application No. 10/972,765. *See* Office Action at 2. Applicant respectfully requests that this rejection be held in abeyance until all other substantive issues in this case have been resolved. The filing of a terminal disclaimer in this case does not constitute an admission of the propriety of the obviousness-type double patenting rejection. *See* MPEP § 804.02 and *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991).

**II. The Anticipation Rejection of Claims 1-7, 10, 11, 14, 16, and 17**

Claims 1-7, 10, 11, 14, 16, and 17 stand rejected under 35 U.S.C. § 102(e), as allegedly being anticipated by U.S. Patent No. 7,249,175 to Donaldson. *See* Office Action at 3. Particularly, the Examiner contends that Donaldson discloses each and every element recited in the respective claims. *See id.* Applicant respectfully disagrees and traverses this rejection on the following grounds.

As stated in MPEP § 2131, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

**A. Donaldson fails to disclose “a diversion address” as recited in independent claims 1, 14, 16, and 17**

Donaldson fails to disclose “a diversion address A’\_1” and more particularly “an intercepting means for ... substituting the diversion address A’\_1 for the to-address A\_1 in the RCPT reply ... if the message is determined to be unsolicited” as recited in independent claim 1 and similarly recited in independent claims 14, 16, and 17. Donaldson does not implement a diversion address whatsoever. Instead, Donaldson implements a Quarantine Database 1610 for storage of rejected messages. *See* Donaldson at col. 36:25-26. A rejected email message is saved to a separate file in the quarantine directory, which is specified by a pathname such as /var/spool/asmtmp/QD. *See id.* at col. 38:26-35.

1. Patentable weight has to be given to the recited claim term “diversion address”

Patentable weight has to be given to the recited claim term “diversion address,” contrary to the Examiner’s assertion. *See* Office Action at 10. All words in a claim must be considered in judging the patentability of a claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). While it may be true that the terms “A’\_1” and “A\_1” refer to general data per se, the Examiner cannot overlook the fact that Applicant is claiming a diversion address or a to-address, respectively. A “diversion address” is a definite term to one of ordinary skill in the art that limits the scope of the claims and hence, should be considered in judging the patentability of those claims over the prior art.

2. A diversion email address is not equivalent to a quarantine file or a quarantine file pathname

Neither quarantine files nor the pathnames associated with those files are equivalent to a diversion address. The claimed diversion address “A’\_1” is an email address that is substituted for the “to-address A\_1,” which is also an email address (i.e., the recipient’s email address), in the RCPT reply command. *See* Applicant’s Specification at ¶ 20 (“If the message is suspected of being unsolicited and the to-address is in the save\_spam database then it logs the rejected message in a rejected\_connection database, looks up the diversion address A’\_1 in the diversion

database, substitutes A'\_1 for A\_1 in the RCPT command, and sends the modified RCPT command to MTA\_1 and allows the conversation to proceed.”). This diversion address “A'\_1” is a separate email address to which the client (i.e., intended recipient of the unsolicited message) wishes to divert their unsolicited messages. *See id.* at ¶¶ 55 and 101. Simply put, an email address is not a file or a file pathname. Accordingly, it cannot be said that Donaldson is substituting a “diversion address” for the “to-address” in the RCPT reply as recited in claims 1, 14, 16, and 17.

The Examiner’s basis for contending that Donaldson discloses such a limitation is unsound. Particularly, the Examiner appears to argue that “appending the recipient address when a message is determined to be unsolicited and otherwise to be quarantined” as allegedly taught by Donaldson is equivalent to the missing limitations noted above. *See* Office Action at 10. Applicant respectfully submits that this argument has no merit. Appending the recipient’s address (i.e., the “to-address”) to a quarantined file does not fulfill the limitation of substituting a diversion address for the recipient’s address in a RCPT reply as claimed. Donaldson makes no mention whatsoever of a diversion address or altering the RCPT reply in such a manner. Moreover, a quarantined file is not a RCPT reply. Furthermore, if the Examiner’s reasoning was followed to its logical conclusion, in essence the Examiner is alleging that Donaldson teaches substituting the appended address (i.e., the “to-address”) for the “to-address,” which does not make sense to one of ordinary skill in the art.<sup>1</sup>

**B. Donaldson discloses intercepting communications between a sending MTA and a receiving MTA before a RCPT command from the sending MTA is received, which is the opposite of what is recited in independent claims 1 and 14**

Donaldson fails to disclose “wherein the unsolicited message diverting communications processor does not intercept communications between MTA\_0 and MTA\_1 before a RCPT command from MTA\_0 is received by the unsolicited message diverting communications

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<sup>1</sup> It is not readily clear what the Examiner is pointing to in Donaldson to fulfill the claimed diversion address. Nonetheless, Applicant is assuming that the Examiner is equating the appended recipient address to the claimed diversion address. If this assumption is not correct, Applicant requests further clarification from the Examiner as to what elements (e.g., the appended address or the quarantined file) within Donaldson are alleged to be a diversion address and a modified RCPT command.

process” as recited in independent claim 1 and “whereby MTA\_1 controls the interaction between MTA\_0 and MTA\_1 before a RCPT command from MTA\_0 is received” as recited in independent claim 14. Donaldson clearly does the opposite. Referring to Fig. 13, Donaldson discloses an active filter proxy 1401 intercepting communications between a remote MTA 1400 and a local MTA 1402 – the remote MTA 1400 attempting to send a message to the local MTA 1402. As shown, the active filter proxy 1401 intercepts several SMTP command communications from the remote MTA 1400, e.g., HELO and MAIL, prior to receiving a RCPT command from the remote MTA 1400. The active filter proxy 1401 intercepts these commands so that it may determine through several tests whether to reject the message or close the connection with the sending 1400 prior to opening a connection with the local MTA 1402. *See, e.g., id.* at col. 16:59-66 (“If the proxy 1401 does not reject the MAIL From transaction 1413 following the Active Dialup, Active Relay and/or Active User testing, then in step 1470 the proxy opens a data connection to the MTA 1402.”)(emphasis added). In other words, Donaldson’s active filter proxy 1401 is not communicating with the local MTA 1402 until after it processes and tests the information contained in the HELO and MAIL commands and determines that the message is acceptable. Thus, it cannot be said that Donaldson’s active filter proxy 1401 is not intercepting communications between the sending and receiving MTAs prior to a RCPT command as claimed in claim 1. In addition, it cannot be said that Donaldson’s local MTA 1402 (i.e., the receiving MTA) is controlling the interaction between the remote MTA 1400 and the local MTA 1402 before a RCPT command is received as claimed in claim 14. Clearly, Donaldson’s active filter proxy is intercepting the HELO and MAIL commands, and controlling the communications with the remote MTA 1400 prior to it receiving a RCPT command.

In sum, Donaldson fails to disclose at least two limitations recited in independent claims 1 and 14, and at least one limitation in independent claims 16 and 17. Claims 2-7, 10, and 11 are not anticipated by Donaldson at least because they depend on claim 1. Applicant respectfully requests the Examiner to withdraw the anticipation rejection of claims 1-7, 10, 11, 14, 16, and 17.

### **III. The Obviousness Rejections of Claims 8, 9, 12, and 13**

Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a), as allegedly being unpatentable over Donaldson in view of U.S. Patent Application Publication No. 2002/0087641 to Levosky, in view of U.S. Patent Application Publication No. 2004/0015554 to Wilson. *See* Office Action at

7. Claim 12 and 13 stand rejected under 35 U.S.C. § 103(a), as allegedly being unpatentable over Donaldson in view of Levosky. *See id.* at 8. Applicant respectfully disagrees and traverses these rejections on the following grounds.

Levosky and Wilson fail to cure the deficiencies of Donaldson. Levosky discloses an alias email address, which the user associated with such may provide to senders of email. *See* Levosky at abstract. Wilson discloses a challenge-response technique for a sender of email to confirm that it is not source of spam. *See* Wilson at abstract. Neither of these references teach nor suggest implementing a diversion address and substituting a diversion address for the to-address in a RCPT command as claimed. Accordingly, Donaldson, either taken alone or in combination with Levosky and/or Wilson, fails to teach or suggest “an intercepting means for ... substituting the diversion address A’\_1 for the to-address A\_1 in the RCPT reply ... if the message is determined to be unsolicited” as recited in independent claim 1. Claims 8, 9, 12, and 13 are not obvious at least because they depend from claim 1, which is not obvious.

The Examiner is respectfully requested to withdraw the obviousness-type rejection of claims 8, 9, 12, and 13.

#### **IV. Conclusion**

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously requested. In order to expedite resolution of any issues and to expedite passage of the present application to issue, the Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number if any comments, questions, or suggestions arise in connection with the present application.

Applicant is submitting herewith the requisite fees for a one-month extension of time and Notice of Appeal for entry and consideration of this Pre-Appeal Brief.

Respectfully submitted,

Dated: May 6, 2009

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